

Remarks

Description of Amendments

Without prejudice, claims 26 and 34 have been amended to make clear that the subject matter of the claim is a transceiver in the telecommunications field. Support for this amendment can be found throughout the specification including, for example, the field of invention as discussed below in greater detail.

Request for Reconsideration under 37 C.F.R §1.111

Applicants respectfully request that the Examiner reconsider her position with respect to her rejection of Claims 26-31 and 34-40, 42-43. Specifically, in rejecting these claims, the Examiner has maintained her rejection as set forth in the first Office Action. The Examiner stated that "*Smith* discloses the claimed invention except for a connector interface at the front of said housing, said connector interface being adapted for receiving a connector of an electrical or optical conductor." The Examiner states, however, that "*Hall* discloses a connector interface of the front of the housing, the connector interface being adapter for receiving a connector of an electrical or optical connector." The Examiner therefore concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Smith* to provide the connector interface at the front of the housing as taught by *Hall* so as to supply signal to the system." The Examiner adds in the most-recent rejection that *Gaio* discloses a transceiver module and that "it would have been obvious . . . to modify *Smith* and *Hall* the transceiver as taught by *Gaio* because that would enable basic *Smith* type cartridge and connector to have wider use."

In reply, Applicants submit that (1) *Smith* and *Hall* are not analogous to the claimed invention, and (2) there is no motivation to modify the module of *Smith* to be a telecommunication transceiver module.

Smith and Hall are Not Analogous Prior Art

The applicants respectfully resubmit the previous argument that *Smith* and *Hall* are not valid references to support a rejection under 103(a) because they are not analogous prior art. This previously-submitted argument is even more compelling now following the amendment of the claims in question to cover specifically *telecommunication transceiver* modules. "To rely on a reference as a basis for rejection of an applicants' invention, the reference must either be in the field of the applicants' endeavor or, if not, then must be reasonably pertinent to the particular problem with which the inventor was concerned." M.P.E.P. §2141.01(a) citing *In re Oetiker*, 977 Fed 2nd 1443 (Fed. Cir. 1992). In this case, *Smith* and *Hall* are neither in the applicants' field, nor are they reasonably pertinent to the problem with which the inventor was concerned.

The field of the applicants' endeavor is clearly set forth in the claims themselves. As amended with the submission of the RCE and further herewith, the claims in question are directed to a *telecommunications transceiver* module. The applicants' field of endeavor is also set forth in the Field of Invention:

The present invention relates generally to electronic connector systems and, more specifically, to low-profile connector systems for pluggable electronic modules, such as transceiver modules for high speed fiber optical and copper communications.

Therefore, the field of the applicants' endeavor for the claims in question is clearly a telecommunication transceiver.

On the other hand, *Smith* is directed to a video game apparatus for connection to a standard television set. Specially, as set forth in its Field of Invention:

[*Smith*] relates generally to video game apparatus and, more particularly, to a self-contained video signal generating device for use in association with a standard black-and-white or color television set and which includes preprogrammed data relating to several selectable games as well as means for receiving a preprogrammed cartridge containing other data that may be selected to provide additional game play.

Hall is directed to a cathode ray tube display terminal. As set forth in its Field of Invention:

The invention [of *Hall*] relates generally to cathode ray tube display terminals and more specifically to the protection of the logic board during shipment and during normal operation of the terminals, thereby allowing customer replacement of the logic board without damage to the logic board or injury to the customer.

Therefore, *Smith* relates to video games and *Hall* relates to a CRT terminal. Neither of these fields relates to telecommunications--much less to a transceiver module for telecommunications.

Since *Smith* and *Hall* lay outside the field of applicants' endeavor, the issue becomes whether the references are reasonably pertinent to the particular problem with which the inventor was concerned. Here, the claimed invention is aimed at a telecommunication transceiver module which facilitates miniaturization and EMI protection. More specifically, the claimed invention is directed to a transceiver module that "facilitates miniaturization and high operating frequencies [characteristic of telecommunications] by effectively shielding EMI emissions to eliminate leaks" (App. Summary of Invention). To this end, the transceiver module of the claimed invention comprises walls to shield the circuit board it contains and prevent EMI emissions. The transceiver module also comprises, in a preferred embodiment, grounding tabs to channel EMI to ground.

It is inconceivable to Applicants why one skilled in the art would look to *Smith* and *Hall* to solve a problem of configuring a transceiver module which is suitable for miniaturization and EMI reduction in the telecommunications field. That is, as mentioned above, *Smith* is directed at a preprogrammed cartridge for expanding the type of video games available for play, and *Hall* is directed to the protection of the logic board of a CRT terminal during shipment and during normal operation of the terminals. Neither reference mentions a transceiver module for telecommunications--much less the need to miniaturize and control EMI. Indeed, the components of *Smith* and *Hall* operate at frequencies that are not typically used in telecommunications and do not result in significant EMI. Therefore, there is not a scintilla of evidence suggesting that one skilled in the art would turn to *Smith* and *Hall* to solve the problem of designing a telecommunication transceiver for miniaturization and EMI reduction.

Therefore, since *Smith* and *Hall* are not in the field of the claimed invention, and since one skilled in the art would not find the references reasonably pertinent to solve the problem with which the inventor was concerned, *Smith* and *Hall* are not analogous art. Accordingly, the references should be removed and the claims allowed.

There is No Motivation to Modify the Cartridge of Smith to be a Telecommunication Transceiver Module

Even if *Smith* and *Hall* are considered analogous art (which they are not), there is no motivation to modify the module of *Smith* to be a transceiver in accordance with *Gaio* as suggested by the examiner. *To the contrary*, the proposed modification to *Smith* would make it unsuited for its intended purpose. It is well established in US patent law that there can be no motivation to modify a reference if that modification would destroy the intended purpose of the reference.

Here, *Smith* states quite clearly that the module or cartridge 28 provides additional memory to increase the selection of games available to the user. *Smith* states in its Summary of Invention:

Another object of [*Smith*] is to provide a video game apparatus which can be selectively programmed, through the use of interchangeable preprogrammed electronics containing cartridges or the like, to include data relating to a large plurality of various games.

(col. 1, 11.42-48). In the Detailed Description, *Smith* adds:

The cartridge 28 includes preprogrammed electronics which cooperate with the permanent electronics of the console to enable games other than those contained in the console circuitry to be played.

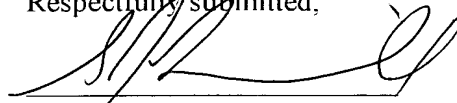
(Col. 3, 11. 3-7.) Therefore, the purpose of *Smith*, and the cartridge 28 in particular, is quite clear—to provide preprogrammed electronics to a game console.

Modifying the cartridge 28 of *Smith* to be a telecommunication transceiver module as disclosed in *Gaio* would invariably undermine its ability to augment a game console with preprogrammed electronics. Indeed, the cartridge of *Smith* is so far removed from a telecommunication transceiver (as addressed above) that contemplating how it would be modified into a

telecommunication transceiver is frankly mystifying. Nevertheless, since the cartridge cannot, as a practical matter, function both as auxiliary electronics to a game console and as a telecommunication transceiver, there can be no motivation to modify it in such a way. Accordingly, the rejection should be withdrawn and the claims allowed.

In light of the above remarks, an early and favorable response is earnestly requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'SJD', followed by a horizontal line and a small flourish.

Stephen J. Driscoll, Esquire
Registration No. 37,564
Attorney for Applicant
The Whitaker Corporation
4550 New Linden Hill Road
Suite 140
Wilmington, DE 19808
Telephone: (215) 923-4466
Facsimile: (302) 633-2776

SJD/dl